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EXAMINER

GORT, ELAINE L

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/995,294
Filing Date: November 26, 2001
Appellant(s): DANG ET AL.

Dan C. Hu
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/11/2008 appealing from the Office action mailed 3/18/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

Claims 14 and 20-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson et al. (Pub US 2002/0052792) as presented in the Final Office Action.

The following new grounds of rejection has also been added.

Claims 1, 2, 4, 6, 7, 9-13, 17-19 and 23-25 are rejected with new grounds for rejection under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (Pub US 2002/0052792) in view of Thomson (WO 01/71606); Gage (Tools Introduced to Aid with Growing EFT Tax Payments) and Examiner's Official Notice. This rejection uses Thomson and Gage instead of the Official Notice presented in the Final Office action to show that XML and TXP formatting are old and well known.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

20002/0052792	Johnson et al.	5-2002
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WO 01/71606 (PCT)	Thomson, Robert	9-2001
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Gage, Theodore Justin; "Tools Introduced to Aid with Growing EFT tax Payments";
Corporate Cashflow, vol 14, Iss. 7; pg. 12, 2 pgs; Jun 1993.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is the rejection presented in the Final Office action for claims 14 and 20-22:

1. Claims 14 and 20-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson et al. (Pub US 2002/0052792).

Johnson et al. discloses the claimed service provider computer system to provide a tax calculation and payment service, the service provider computer system (service provider computer system is construed by the Examiner to include not only the system administrators on-line system but also the consumer's lending institution's on-line computer system) comprising:

A web server to receive transaction requests from subscriber computer systems associated with corresponding merchants who have subscribed to the tax calculation and payment service (for example, see figures 11 and 12 and paragraph [0105] disclosing system administrator providing merchants and their on-line customers with tax information from transaction requests);

One or more additional servers having a services module executable in the one or more additional servers (for example, the system administrator and the Merchant's financial institution website's servers), the services module comprising:

A first module to store transaction data of the transaction requests in at least one first file (for example, [0107] discloses that system administrator sends transaction reports to the state/local tax administration which inherently includes transaction data. Paragraph [0101] discloses that the system's website is capable of

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working with “numerous markup languages” and the system administrator website 96 is written in all languages presently known or that may be hereinafter developed to design and create websites. Examiner notes that XML is a broadly used language for Web developers that is defined as a language standard published by the W3C and supported by the computer industry);

A tax computation module to compute tax due on transactions corresponding to the transaction data (system administrator website calculates tax due on transactions, for example see paragraph [0105]) and to store the tax due in at least one second file (tax information is sent to the web merchant in order for the merchant to communicate the tax amount to the customer’s lending institution to be put into the tax account of the web merchant’s. For example see [0106]); and

A tax remission module to convert the at least one second file from a first format to a second format for use by an automated clearing house network (Johnson et al discloses the conversion of data formats because Johnson et al. discloses data being collected via a website written in “all languages presently known or that may be hereinafter developed to design and create websites”, see [0101], and the ability to send related data to an ACH in order for funds to transfer, which requires a TXP format, therefore conversion takes place.), and the tax remission module to transmit the at least one second file in the second format of a financial institution for remission of funds relating to the tax due (for example [0106] discussed the transmitting of funds to the Merchant’s tax account and subsequently to the state escrow account, data must be sent to the ACH in the proper format in order for the funds to be transferred).

Regarding the generation of periodic tax returns, Johnson et al. discloses the generation of tax remittance reports which the Examiner is broadly construing to be “tax returns”. Examiner notes that these remittance reports are electronic “forms” on which a taxpayer makes a statement of income and personal circumstances, used to assess liability for tax, which is in line with the dictionary definitions provided by the Applicant.

Regarding reporting of tax information to one or more government authority, Johnson et al. discloses in paragraph [0107] that transaction reports are sent to “state/local tax administration”. The Examiner construes this to mean that transaction reports are sent to state and local tax administration. Figures 7 and 8 and Paragraph [0082] discusses determining taxing jurisdictions and locations.

NEW GROUND(S) OF REJECTION

The following rejection uses Thomson and Gage instead of the Official Notice presented in the Final Office action to show that XML and TXP formatting are old and well known.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1, 2, 4, 6, 7, 9-13, 17-19 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (Pub US 2002/0052792) in view of**

Thomson (WO 01/71606); Gage (Tools Introduced to Aid with Growing EFT Tax Payments) and Examiner's Official Notice.

Johnson et al. discloses the claimed service provider computer system but is silent regarding specifically using XML and TXP based formatted data. Thomson teaches in that it is old and well known in on-line computer industry to XML formatted data for communicating between servers and is a widely known markup language and would be a design choice (see lines 11+ on page 19). Gage teaches that it is old and well known in the financial clearinghouse industry to use TXP-based format and to automatically format TXP payment information to meet state requirements (for example see paragraphs 5+). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the website of Johnson with the XML formatting taught by Thomson to utilize a widely known markup language and to provide the clearinghouse of Johnson with TXP formatting as taught by Gage in order to format payment information to meet state requirements.

Regarding the distribution of software functionality over a particular set of servers, the Examiner takes Official Notice that it is notoriously old and well known in the art to use any number of servers to reduce the load on any one server and to divide the work among different servers.

Regarding the use of redundant servers, the Examiner takes Official Notice that it is notoriously old and well known in the art of networked servers to have redundant servers to provide back up in the event the server has problems or can not carry the full load of the work to be processed.

Regarding a security, backup, real-time accessibility, system monitoring, load balancing and scalability applications, the Examiner takes Official Notice that it is notoriously old and well known in the art of networked servers to have these applications to provide security, back up, real time, monitor the system and to provide load balancing and scalability to the system.

Regarding modular programming, the Examiner takes Official Notice that it is notoriously old and well known in the art of computer programming to have modular applications which can work together to perform the work for a larger program while still remaining individually useable. In modular software components are functionally autonomous and self-contained, other components can call on its services with out having to know how it works.

(10) Response to Argument

A. Claims 1, 2, 4, 6, 7, 9-13, 17-19 and 23-25

Appellant has traversed the examiner's reliance on "common knowledge", the new grounds of rejection made above have been made to show teachings of this matter previously claimed by the Examiner to be common knowledge. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Applicant has merely recited that the Official Notice is improper and has not specifically discussed what the "improper" Official Notice lacks.

Appellant argued that since the Examiner used Wiles to teach XML formatting but later took Official Notice of XML formatting that the removal of the Wiles reference is "evidence" that XML formatting is not well known. The new grounds of rejection include Thomson to show that XML formatting is well known.

Appellant has argued that Johnson does not delineate a server associated with a merchant from servers associated with a service provider computer system. Examiner contends that Johnson discloses a delineated merchant server, such as the web merchant computer 104 shown in figure 12, associated with a merchant that is separate and thus delineated from servers associated with a service provider computer system, which for example includes the system administrator 108, consumer's lending institution, 118, web merchants bank 122, that receives transaction information, calculates tax and transfers the tax funds, from the tax account to the state escrow account 128. In this manner the defined service provider computer system performs the acts of transferring the tax payments and not the merchant, as the Applicant has argued. The fact that communications go thru the web merchants server does not precluded the defined servers of the "service provider servers" as carrying out the claimed functions.

Appellant argues that in Johnson the transfer of accumulated tax to the stat account is performed by the merchant, not the system administrator. Johnson states in [0107] that the bank 122 transfers tax to state escrow accounts. Examiner has defined the service provider to include the bank system.

Appellant argues that Johnson's system administrator, consumer's lending institution and bank are not "a" service provider. Examiner contends that the definition of a service provider is broad enough to include them. A service provider is an organization that provides services and an organization is a group organized to accomplish a goal. The system administrator, lending institution and bank all are organized to accomplish a goal, the goal being the payment and reporting of taxes to a taxing authority.

Appellant argues that the feature of converting XML to TXP is not of such instant and unquestionable demonstration to defy dispute. The system of Johnson discloses in paragraph [0058] a server supporting "any operating system and executing any computer language and software to efficiently carry out the essential functions prescribed in the patent" and in [0102] and [0104] disclose the funds being transferred via an ACH (clearing house) which requires ACH specified formatting in order to transfer the funds, therefor it is arguable that in Johnson the original formatting is converted to meet the ACH required format. Additionally, Gage teaches software used to automatically format payment information to meet TXP requirements (abstract and paragraph 7).

Appellant argues that the withdrawal of the Propel reference is conceding to the official notice taken. Propel was used to teach modular architecture in Examiner Steven McAllister's final action mailed on 4/19/06. However, this teaching is not necessary as Johnson has a modular architecture, for example [0034] discloses a system having individual software and database modules which are separate functional elements.

B. Claims 14 and 20-22

Appellant argues that Johnson's system administrator, consumer's lending institution and bank are not "a" service provider. Examiner contends that the definition of a service provider is broad enough to include them. A service provider is an organization that provides services and an organization is a group organized to accomplish a goal. The system administrator, lending institution and bank all work together/are organized to accomplish a goal, the goal being the payment and reporting of taxes to a taxing authority.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR

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41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Elaine Gort/

Primary Examiner, Art Unit 3687

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Wynn Coggins/

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Director, Technology Center 3625

Appeal Conferees:

Vincent Millin /VM/
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/Matthew S Gart/

Supervisory Patent Examiner, Art Unit 3687